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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,263	06/02/2000	Donald F. Gordon	19880-002210	5643

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MOSER, PATTERSON & SHERIDAN L.L.P.
595 SHREWSBURY AVE, STE 100
FIRST FLOOR
SHREWSBURY, NJ 07702

EXAMINER

SALTARELLI, DOMINIC D

ART UNIT PAPER NUMBER

2611

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,263

Applicant(s)

GORDON ET AL.

Examiner

Dominic D Saltarelli

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saib et al. (5,973,682, of record) [Saib] in view of over Hooper et al. (5,422,674, of record) [Hooper].

Regarding claim 1, Saib discloses a method for providing a channel information window ('program list' or EPG, col. 4, lines 30-35, 47-56) overlaying a broadcast video (shown in fig. 7, col. 6, lines 33-46, where the channel information window is the displayed EPG data, and the broadcast video display is shown as region 710, corresponding to applicant's disclosed layout of an information window overlaying a video display, shown in figs. 3a-c of applicant's disclosure), the method comprising:

Transmitting a broadcast video presentation from a server to a terminal (col. 3, lines 14-57);

Receiving at the terminal (the 'system front end') a signal to activate the channel information window (actuation of 'EPG' key on controller, col. 5, lines 3-9); and

Overlaying the channel information window over the broadcast video at the terminal on a display associated with the terminal (col. 4, lines 30-35, 47-56).

Saib fails to disclose transmitting a bitmap for the channel information window from a server system to the terminal.

In an analogous art, Hooper teaches creating a bitmap (col. 6, lines 43-49) for use in a user interface (col. 5, lines 49-59) at a server system (authoring station is part of the server system, col. 5, lines 1-10), which is transmitted to user terminals (col. 6, lines 15-24), making for a highly flexible user interface.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Saib to include transmitting a bitmap for a user interface from a server system to the terminal, as taught by Hooper, for the benefit of a highly flexible user interface for a channel information window, where the graphical display options for creating the information window are virtually unlimited.

Regarding claim 3, Saib and Hooper disclose the method of claim 1, wherein the transmitting of the bitmap comprises encoding at the server the bitmap to generate an encoded bitmap (Hooper, col. 6, lines 58-61), transmitting the encoded bitmap to the terminal, and receiving at the terminal the encoded bitmap (Hooper, col. 6, lines 15-24).

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Regarding claim 5, Saib discloses a method for navigating between TV channels (col. 6, lines 43-46 and col. 6 line 61 col. 7 line 4), the method comprising:

Transmitting broadcast video displays on multiple TV channels from a server to a terminal (col. 3, lines 14-57);

Overlaying a channel information window on a broadcast video display on a display (shown in fig. 7, where the channel information window is the displayed EPG data, and the broadcast video display is shown as region 710, corresponding to applicant's disclosed layout of an information window overlaying a video display, shown in figs. 3a-c of applicant's disclosure);

Navigating among channels within the channel information window by selecting information about another channel (using the system pointer, col. 7, lines 17-19); and

Changing the broadcast video display in synchronization with the navigating among channels within the channel information window (col. 7, lines 23-27).

Saib fails to disclose transmitting the channel information window having information about multiple channels from the server to the terminal.

In an analogous art, Hooper teaches creating a bitmap (col. 6, lines 43-49) for use in a user interface (col. 5, lines 49-59) at a server system (authoring station is part of the server system, col. 5, lines 1-10), which is transmitted to user terminals (col. 6, lines 15-24), making for a highly flexible user interface.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Saib to include transmitting a bitmap for a user interface from a server system to the terminal, as taught by Hooper, for the benefit of a highly flexible user interface for a channel information window, where the graphical display options for creating the information window are virtually unlimited.

Regarding claim 7, Saib and Hooper disclose the method of claim 5, wherein changing the broadcast video display is accomplished by changing video packet streams (Saib, col. 5, lines 35-45).

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saib and Hooper as applied to claim 1 above, and further in view of Banker et al. (5,247,364, of record) [Banker].

Regarding claim 2, Saib and Hooper disclose the method of claim 1, but fail to disclose the transmitting step is performed via an out of band channel.

In an analogous art, Banker teaches receiving data via an out of band channel (col. 2, lines 55-65), enabling receiving terminals to receive data regardless of which channel the terminal is currently tuned to (col. 2, lines 65-68).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Saib and Hooper to include transmitting via an out of band channel, as taught by Banker, for the benefit of enabling receiving

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terminals to receive the transmitted data regardless of which television channel the terminal is currently tuned to.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saib and Hooper as applied to claim 5 above, and in further view of Billock et al. (5,619,249, of record) [Billock].

Regarding claim 8, Saib and Hooper disclose the method of claim 5, wherein the navigating among channels occurs using a special button (Saib, 'direction key', col. 5, lines 3-5) on a remote control (Saib, fig. 3, col. 4 line 57 – col. 5 line 9).

Saib and Hooper fail to disclose looping through a series of channels.

In an analogous art, Billock teaches scrolling through a series of channels in a displayed program guide in an endless loop (col. 10, lines 36-45), enabling a user to quickly return to the beginning of a list of channels once reaching the end of the list.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Saib and Hooper to include looping through a series of channels, as taught by Billock, for the benefit of enabling a user to quickly return to the beginning of a list of channels once reaching the end of the list, so as not to be forced to traverse the list in the opposite direction.

Response to Arguments

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5. Applicant's arguments filed November 24, 2004 have been fully considered but they are not persuasive.

Regarding claims 1 and 3, applicant asserts that the combination of Saib and Hooper fails to disclose the claimed invention as a whole, citing:

A) Hooper does not disclose transmitting both a broadcast video presentation and a channel information window from a server to a terminal nor does he disclose selectively overlaying the channel information window bitmap on the broadcast video (page 9)

B) Hooper does not suggest that the guide can be or should be overlaid on a broadcast video signal (page 9).

Regarding A), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant application, the feature of transmitting both channel guide and broadcast video information is not taught by the Hooper reference, but by the Saib reference, as shown above regarding claim 1.

Regarding B), a lack of suggestion in Hooper to overlay the guide onto the broadcast signal is not sufficient to prove the invention is not taught as a whole by the combination, as Saib explicitly teaches overlaying the channel guide onto the broadcast signal, as described above regarding claim 1.

The only deficiency of the Saib reference regarding the claimed invention is transmitting the channel guide as bitmap data from the server to the terminal, which is taught by Hooper. The suggestion to do so is the benefit of a vastly more flexible system which can display essentially unlimited variations of channel guide, as the graphical interface data is generated and sent by the server, which is a benefit made clear to one of ordinary skill in the art upon reading the Hooper reference (such as col. 6, lines 42-57).

Further, the two inventions described are clearly compatible and combineable, as Saib teaches receiving distinct streams of data, both broadcast programming and EPG data (col. 3, lines 41-57), wherein the bitmap image data equates to EPG data (as it is itself an MPEG stream, Hooper, col. 6, lines 25-41), and storing the EPG data in memory (Saib, col. 4, lines 47-56) for later recall and overlay over broadcast programming (Saib, fig. 7).

Regarding claim 5, examiner has set forth new grounds of rejection, rendering applicant's remarks concerning claim 5 (page 6) moot in view of the new grounds. The new grounds are a modification of Saib in view of Hooper to include sending the channel information window from the server to the terminal, similar to the manner described regarding claim 1.

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Regarding claims 2, 7, and 8, the alleged deficiencies regarding claims 2, 7, and 8 are based upon the alleged deficiencies present in claims 1 and 5, which have been addressed above.

Conclusion

6. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

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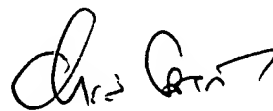
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on M-F 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli
Patent Examiner
Art Unit 2611

DS



CHRIS GRANT
PRIMARY EXAMINER